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09/990,498	11/21/2001	Yue Ma	9432-000145	3411

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EXAMINER

NGUYEN, JIMMY H

ART UNIT PAPER NUMBER

2673

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/990,498

Applicant(s)

MA ET AL.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6,8,11,13-19,21,23-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,11,13-19,21,23-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 04/08/2005.

Claims 1, 3-6, 8, 11, 13-19, 21, 23-26, and 28-30 are currently pending in the application. An action follows below:

#### *Abstract*

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the pending application, the abstract contains three paragraphs and more than 150 words.

#### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features, "indexer" of claims 1, 5, and 26, "a marking device for generating at least one of said digital forms of said user marks selected through said browser onto said panel in said physical form" in last two lines of claim 26, and "a control module", "a processor", and "seamless integration of said scanner and said memory", of claim 29, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

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sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: “system” in line 1 should be changed to “apparatus”, so as to make this limitation consistent with the limitation in line 2 of claim 1 and other dependent claims and “reusable” in lines 11 and 12 should be changed to --whiteboard--, so as to make this limitation consistent with the limitation in line 3. Appropriate corrections are required.
5. Claim 18 is objected to because of the following informalities: “the step” in line 3 should be changed to “a step” because there is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.
6. Claim 26 is objected to because of the following informalities: (i) “browser” appearing several places should be changed to --browser screen--, so as to make the claimed invention

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consistent with the disclosure, see page 5, last three lines, and (ii) “wherein said browser ... said memory” in lines 8-10 should be moved to the end of the claim because there is insufficient antecedent basis for “browser” in the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 8, 13-15, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 8 and 13-15 recite “claim 7” in line 1. There is insufficient antecedent basis for “claim 7” in the claim since claim 7 was previously cancelled.

10. Claim 28 recites “said index” in line 1. There is insufficient antecedent basis for this limitation in the claim.

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 13-15 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The features, “there exists only one circle in each circle region” and “the circle is a concave curve”, which are critical or essential to the practice of the invention, but not included in claims 13 and 23 is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The specification, page 14, lines 15-19, expressly discloses that the method of removing a circle as illustrated by Fig. 4 as well as recited in claims

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13 and 23 can be performed with the presence of the above underlined features, i.e., without these two features, the method of removing a circle in this pending application can't be performing properly. Claims 14, 15, 24, and 25 are also rejected since they depend upon rejected claims 13 and 23.

13. Claims 1, 3-6, 8, 11, 13-15, 18, 19, 23-26, and 28-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claims 1, 3-6, 8, 11, 13-15, 26, and 28-30, these claims contain the feature, "an indexer" (see lines 9-10 of claims 22 and 31), which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure, when filed, specifically page 3, line 8 and original claim 1, discloses exactly what currently presented in independent claims 1 and 26. However, the disclosure, specifically drawings, does not disclose a system comprising an element, "an indexer", and where the indexer is disposed, so as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Additionally to claims 5, 6, and 13-15, these claims contain the features, "removing a circle from the circle region" of claims 5 and 6 and "the step of removing the circle from the circled region ... pixels" in lines 1-8 of claim 13, which were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure, when filed, specifically Fig. 4 and

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the corresponding description, page 13, line 22 through page 15, line 12, only discloses a method of removing a circle **regardless of the circle region**, i.e., only a circle itself without data in the circle. However, the disclosure, specifically drawings, does not disclose a method of removing a circle **from a circle region** including data in the circle region, e.g., “PDMS 200 Plan” as shown in Fig. 5a.

As per claims 18, 19, and 23-25, these claims contain the features, “the step of removing the mark-up from the marked-up region” in line 3 of claim 18, and “a mark-up removal method for removing the mark-up from the marked-up region” of claims 23-25, which were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure, when filed, specifically Fig. 4 and the corresponding description, page 13, line 22 through page 15, line 12, only discloses a method of removing a circle **regardless of the circle region**, i.e., only a circle itself without data in the circle. However, the disclosure, specifically drawings, does not disclose a method of removing a circle **from a circle region** including data in the circle region, e.g., “PDMS 200 Plan” as shown in Fig. 5a.

14. Claims 26 and 28-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims above, the disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed feature, “a marking device for

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generating at least one of said digital forms of said user marks selected through said browser onto said panel in said physical form” in last two lines of independent claim 26. The original disclosure, specifically abstract and original claims 1 and 3, expressly discloses a digitizer corresponding to a scanner for generating digital information corresponding to the user-drawn marks. However, the original disclosure does not disclose a digitizer and a marking device which generates at least one of said digital forms of said user marks, as presently claimed. Also see the corresponding drawing objection above.

Additionally to claim 29, the disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed features, “a control module executed by a processor, said control module providing seamless integration of said scanner and said memory ... said control module formatting said digital forms”... said browser”, in last 5 lines. Furthermore, exact words or similar terminologies of “a control module”, “seamless integration”, and “formatting said digital forms and headers” are not found in the original disclosure. Also see the corresponding drawing objection above.

15. It is noted to Applicants that due to the rejection under 35 USC 112, first and second paragraphs, the following rejections are based as best understood by the examiner.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.



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17. Claims 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Fang et al. (US 6,859,555 B1) hereinafter Fang.

As per claims above, Fang discloses a method for determining and removing a circle from a Region of Interest (ROI) (i.e., the claimed marked-up region) in an image (see Abstract) comprising all the steps of claims 23-25. See Figs. 1 and 2, col. 4, line 32 through col. 5, line 67.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1, 3-6, 8, 11, 16-19, 21, 26, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carau, Sr. (US 6,318,825 B1) hereinafter Carau, and further in view of Weber et al. (USPN: 5,572,651), hereinafter Weber.

As per claims 1, 3, 26 and 30, Carau discloses an integrated apparatus (see Fig. 1) comprising a whiteboard panel (100) for temporary display marks made by inkjet printing mechanism dispensing erasable ink (see col. 2, lines 39-42 and col. 3, line 39); a digitizer or a scanner (image capture means such as a CCD array, col. 2, lines 30-37) for generating digital marks (col. 3, lines 25-36); and a plotter (inkjet printing mechanism, see col. 2, lines 39-42) for providing the whiteboard panel with redisplay capability (see col. 3, lines 36-40). Accordingly, Carau discloses all the claimed limitation except for an indexer, markers, a header, and a browser, as presently claimed.

However, Weber discloses a user using a marker (pen 83, see Fig. 4) to mark a selected text portion as a key object (84, 88) (see Fig. 4). Weber also teaches an indexer for associating digital information with a key object which is extracted from the digital information and based at least in part on a selected portion of the user marks (Figs. 4 and 9 show the key objects such as “handwri”, “WEBER”, and etc., extracted from a digital information and associating with the digital information). Further, Weber teaches a browser for providing an interface for the user to select the key objects stored in the memory (see Fig. 9). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide an indexer, a browser, and markers (it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to recognize that the markers for use with Carau’s whiteboard must be dry erase ink, see Carau, col. 3, lines 36-40), in the Carau apparatus, in view of the teaching in the Weber reference, because this would provide the user the ability to retrieve user-produced information with special information designators which are used as access (indexing) mechanism into the user-produced data, without recognition or interpretation of the data, as taught by Weber. See col. 3, line 45 through col. 4, line 20 for additional benefits. Accordingly, the combination of Carau and Weber discloses all the claimed limitations except for a header. However, Weber further teaches that the key object (84, 88, 92, and etc.) can be inserted many places in a text (see Figs. 4, 7 and 9). While Weber may not exemplify the key object being used as a header, one of ordinary skill in the art would have found it obvious to use the key object as a header in accordance with a particular application.

As per claim 4, Weber discloses the selected portion of the user-drawn marks corresponding to a circled region of the displayed text (see Figs. 4, 7 and 9).

As per claims 5 and 28, Weber also teaches an index method comprising a step of extracting a circled region (key objects 84, 88, 92, and etc., see Figs. 4, 7, and 9), a step of removing a circle from the circle region prior to associating the digital information (Fig. 9 shows that a circle corresponding to "JACK's" is removed prior to associating with the digital information). The combination of Carau and Weber obviously discloses a step of constructing a header and associating the digital information with the header (see the rejection to claims 1 and 26 above).

As per claim 6, Weber also teaches the user-drawn marks containing plural circle regions (see Figs. 4, 7 and 9). Accordingly, the combination of Carau and Weber obviously discloses the invention of claim 6.

As per claim 8, as discussed above, Carau in view of Weber discloses the header based on a selected portion of the user-drawn mark. Accordingly, the difference between the combination of Carau and Weber and the invention of claim 8 is a step of constructing recognized text using handwriting recognition on the circled region. However, Official Notice is taken that both the concept and the advantages of constructing recognized text using handwriting recognition on the handwriting text are well-known and expected in the art. It would have been obvious to have included the handwriting recognition in the Carau apparatus because this would allow other participants to easily read the text corresponding to the handwriting text.

As per claim 11, Weber also teaches the apparatus comprising an input display (32) for allowing a user to select key objects and an output display (28) for outputting a plurality of key objects (see Figs. 2 and 9). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide an output display in the Carau apparatus, in view

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of the teaching in the Weber reference, because this would provide the user simultaneously to view plural information.

As per claims 16 and 18, these claim are rejected on grounds presented in the rejections of claims 1 and 5 above.

As per claim 17, this claim is rejected on grounds presented in the rejection of claim 6 above.

As per claim 19, this claim is rejected on grounds presented in the rejection of claim 8 above.

As per claim 21, this claim is rejected on grounds presented in the rejections of claims 8 and 11 above.

As per claim 29, Weber discloses a memory (40), a control module (20, 22, 26) executed by a processor (24), creating the header, and formatting as claimed (see Fig. 2 and the corresponding description). Accordingly, the combination of Carau and Weber discloses the invention of claim 29.

20. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carau in view of Weber, and further in view of Fang.

As per claims above, as discussed above, Weber discloses the step of removing the circle from the circled region; however, Weber does not expressly disclose a circle removal method as presently recited in these claims. However, Fang discloses a method for determining and removing a circle from a Region of Interest (ROI) (i.e., the claimed marked-up region) in an image (see Abstract) comprising all the steps as claimed. See Figs. 1 and 2, col. 4, line 32 through col. 5, line 67. It would have been obvious to a person of ordinary skill in the art at the

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time of the invention was made to provide a circle removal method in the apparatus of Carau, in view of the teaching in the Fang reference, because this method would detect and extract the circle quickly, as taught by Fang (see abstract).

***Response to Arguments***

21. Applicant's arguments with respect to the rejections in the Office Action dated 01/11/2005 have been considered but are moot in view of the new ground(s) of rejection above.

***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Bricklin reference (US 5,539,427) discloses a related graphic indexing system for selecting and indexing information for subsequent retrieval.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

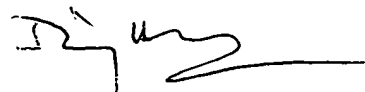
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JHN

November 22, 2005

A handwritten signature in black ink, appearing to read 'JH Nguyen', with a long horizontal flourish extending to the right.

Jimmy H. Nguyen

Primary Examiner

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